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**FACSIMILE COVER SHEET**

TO: USPTO: GAU 3715  
FAX NO.: 571-273-8300  
FROM: Colina Tong, ph. 650-961-5085  
RE: 10/729583  
DATE: April 22, 2007  
TOTAL PAGES (Including this page): 26

MESSAGE (if any):

Transmitted herewith for filing is:

Communication after Notice of Allowance 2 pages  
A copy of previously submitted Notice of Related Cases with a postcard 3 pages  
A copy of the "Answer to Complaint and Counterclaim" 20 pages

Peter Tong  
1807 Linnetree Lane  
Mountain View, CA 94040

PATENT APPLICATION  
Attorney Docket No. 150C3

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Chl Fai Ho, Peter P. Tong  
Serial No.: 10/729583 Examiner: Cheng, Joe H  
Filing Date: December 5, 2003 Group Art Unit: 3715  
Title: Computer-Aided Group-Learning Methods and Systems

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being sent by facsimile (the fax number being ~~571-273-8300~~) to the Commissioner for Patents, P.O.Box 1450, Alexandria, VA 22313-1450 on April 22, 2007.

  
Colina Tong (Signature)

**Communication after Notice of Allowance**  
**(Request for Consideration of Previously Submitted Publication)**

Mail Stop Issue Fee  
Commissioner for Patents  
Alexandria, Virginia 22313-1450

Sir:

Applicants acknowledge with gratitude, the Notice of Allowability regarding the above-identified application, mailed on April 13, 2007. In section 3, on page 3 of the Notice, Applicants were informed that the publication of "Answer to Complaint; Counterclaim by Plateau Systems, Ltd." (Hereinafter referred to as the "Publication") cited in the two Information Disclosure Statement filed on February 23, 2007 and February 1, 2007 were crossed out because the copy of the publication was allegedly missing.

Applicants would like to bring to the attention to the Patent Office that the Publication was previously submitted to and received by the Patent Office on February 5, 2007 as an attachment to a Notice of Related Cases. A copy of the previously-submitted Notice of Related Cases with the corresponding Postcard from the Patent Office acknowledging the submission are included in this communication. In case the Patent


Office has lost the Publication, Applicants also have included in this communication another copy of the Publication.

Applicants respectfully request consideration of the Publication cited in the two Information Disclosure Statements. Further, Applicants respectfully request providing an indication to Applicants that the Publication was considered by the USPTO, and if appropriate, issuing a Supplemental Notice of Allowance.

The Commissioner is hereby authorized to charge underpayment of any fees associated with this communication to Deposit Account No. 50-0727.

Respectfully submitted,

Date: April 22, 2007

By:   
Peter P. Tong  
Reg. No. 35,757  
1807 Limetree Lane  
Mountain View, CA 94040  
(650) 625-8192

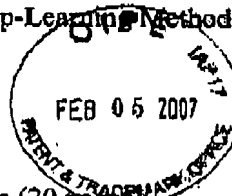
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APR 23 2007

Dear Sir/Madam:

Please acknowledge receipt of the following documents re  
U.S. Patent Application # 150C3

Inventor(s): Ho et al.  
Title of Invention: Computer-Aided Group-Learning Methods  
and Systems  
Serial Number: 10/729,583



- ☒ Notice of Related Cases
- ☒ Answer to Complaint and Counterclaim (20 pages)
- ☐ Information Disclosure Statement & Copies of Documents
- ☐ Pages of Specification, Claims, Abstract \_\_\_\_\_ Claims (Total)
- ☐ Sheets of Formal Drawings
- ☒ First Class Mail
- ☒ Dated: January 10, 2007 By Colina Tong

APR 23 2007

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Ho et al.

Attorney Docket No.: 150C3

Application No.: 10/729,583

Examiner: Cheng, Joe H

Filed: December 5, 2003

Group: 3713

Title: Computer-Aided Group-Learning Methods  
and Systems

## CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence and all enclosures are being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 30, 2007 (Date of deposit)

Type or Print Name of Person Mailing

Signature

Colina Tong

**NOTICE OF RELATED CASES UNDER MPEP 2001.06(c)**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In accordance with MPEP 2001.06(c), Applicants make the PTO aware of the following litigation for related patents in which the subject matter for which a patent is being sought is or has been involved in litigation.

<u>Case Identification</u>	<u>Case Status</u>
E. D. Texas, Action No.: 2:06-CV-00299-TJW	Case Pending

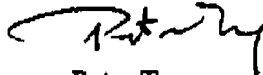
On January 25, 2007, an Answer to Complaint with Counterclaims (hereinafter the "Answers") were filed in the above litigation, challenging the validity of one or more related patents under 35 U.S.C. §§ 101, 102, 103 and 112, and under claims based on inequitable conduct and/or fraud on the USPTO.

Applicants do not believe that the Answers affect the patentability of the pending claims in the above-identified application. However, Applicants are not certain whether the Patent

Office might be interested in such information. Just in case such information may be material to the examination of this application and there may be a duty to disclose in accordance with 37 CFR 1.56, Applicants have included the Answers to assist the Patent Office.

If it is determined that any fees are due, the Commissioner is hereby authorized to charge such fees to Deposit Account 500727.

Respectfully submitted,



Peter Tong  
Registration No. 35,757

1807 Limetree Lane  
Mountain View, CA 94040  
(650) 625-8192

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APR 23 2007

**UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

**IPLEARN, LLC,**

**Plaintiff**

**V.**

**PLATEAU SYSTEMS, LTD.,**

**Defendant**

**CIVIL ACTION NO. 2:06cv299 (TJW)**

**JUDGE WARD**

**JURY TRIAL DEMANDED**

**PLATEAU SYSTEMS, LTD.'S  
ANSWER TO COMPLAINT; COUNTERCLAIM**

In answer to IpLearn, LLC's ("IpLearn") Complaint for Patent Infringement dated July 24, 2006 ("the Complaint"), Plateau Systems Ltd. ("Plateau") admits, denies, and avers as follows:

**JURISDICTION AND VENUE**

1. Plateau admits the averments of Paragraph 1 of the Complaint.
2. In response to Paragraph 2 of the Complaint, Plateau admits that venue is proper in this district. Except as expressly admitted, Plateau denies the averments of Paragraph 2 of the Complaint.
3. In response to Paragraph 3 of the Complaint, Plateau admits that venue is proper in this district. Except as expressly admitted, Plateau denies the averments of Paragraph 3 of the Complaint.

PLATEAU SYSTEMS, LTD.'S ANSWER TO  
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### **THE PARTIES**

4. Plateau admits the averments of Paragraph 4 of the Complaint.
5. Plateau admits the averments of Paragraph 5 of the Complaint.
6. In response to Paragraph 6 of the Complaint, Plateau admits that it is registered to do business in Texas as a foreign corporation and has regular contacts with Texas, and that Plateau's foreign corporation lists CT Corporation Systems, 350 N. St. Paul St., Dallas, TX 75201, as its registered agent for service of process. Except as expressly admitted, Plateau denies the averments of Paragraph 6 of the Complaint.

### **FACTUAL ALLEGATIONS**

7. In response to Paragraph 7 of the Complaint, Plateau admits that on its face, United States Patent No. 5,779,486 ("the '486 patent") is entitled "Methods and Apparatus to Assess and Enhance a Student's Understanding in a Subject," that the '486 patent on its face names Chi Fai Ho and Peter P. Tong as alleged inventors, and that a copy of the '486 patent is attached as Exhibit A to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 7, and, on that basis, denies each and every such averment.

8. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 8 of the Complaint, and, on that basis, denies each and every such averment.

9. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 9 of the Complaint, and, on that basis, denies each and every such averment.

10. In response to Paragraph 10 of the Complaint, Plateau admits that on its face, United States Patent No. 5,934,909 ("the '909 patent") is entitled "Methods and Apparatus to Assess and Enhance a Student's Understanding in a Subject," that the '909

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patent on its face names Chi Fai Ho and Peter P. Tong as alleged inventors, and that a copy of the '909 patent is attached as Exhibit B to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 10, and, on that basis, denies each and every such averment.

11. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 11 of the Complaint, and, on that basis, denies each and every such averment.

12. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 12 of the Complaint, and, on that basis, denies each and every such averment.

13. In response to Paragraph 13 of the Complaint, Plateau admits that on its face, United States Patent No. 6,118,973 ("the '973 patent") is entitled "Methods and Apparatus to Assess and Enhance a Student's Understanding in a Subject," that the '973 patent on its face names Chi Fai Ho and Peter P. Tong as alleged inventors, and that a copy of the '973 patent is attached as Exhibit C to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 13, and, on that basis, denies each and every such averment.

14. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 14 of the Complaint, and, on that basis, denies each and every such averment.

15. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 14 of the Complaint, and, on that basis, denies each and every such averment.

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16. In response to Paragraph 16 of the Complaint, Plateau admits that on its face, United States Patent No. 6,126,448 ("the '448 patent") is entitled "Computer-Aided Learning Methods and Apparatus for a Job," that the '448 patent on its face names Chi Fai Ho and Peter P. Tong as alleged inventors, and that a copy of the '448 patent is attached as Exhibit D to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 16, and, on that basis, denies each and every such averment.

17. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 17 of the Complaint, and, on that basis, denies each and every such averment.

18. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 18 of the Complaint, and, on that basis, denies each and every such averment.

19. In response to Paragraph 19 of the Complaint, Plateau admits that on its face, United States Patent No. 6,213,780 ("the '780 patent") is entitled "Computer-Aided Learning and Counseling Methods and Apparatus for a Job," that the '780 patent on its face names Chi Fai Ho and Peter P. Tong as alleged inventors, and that a copy of the '780 patent is attached as Exhibit E to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 19, and, on that basis, denies each and every such averment.

20. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 20 of the Complaint, and, on that basis, denies each and every such averment.

21. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 21 of the Complaint, and, on that basis, denies each and every such averment.

PLATEAU SYSTEMS, LTD.'S ANSWER TO  
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22. In response to Paragraph 22 of the Complaint, Plateau admits that on its face, United States Patent No. 6,398,556 ("the '556 patent") is entitled "Inexpensive Computer-Aided Learning Methods and Apparatus for Learners," that the '556 patent on its face names Chi Fai Ho, John P. Del Favero, Jr. and Peter P. Tong as alleged inventors, and that a copy of the '556 patent is attached as Exhibit F to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 22, and, on that basis, denies each and every such averment.

23. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 23 of the Complaint, and, on that basis, denies each and every such averment.

24. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 24 of the Complaint, and, on that basis, denies each and every such averment.

25. In response to Paragraph 25 of the Complaint, Plateau admits that on its face, United States Patent No. 6,685,478 ("the '478 patent") is entitled "Inexpensive Computer-Aided Learning Methods and Apparatus for Learners," that the '478 patent on its face names Chi Fai Ho, John P. Del Favero, Jr. and Peter P. Tong as alleged inventors, and that a copy of the '478 patent is attached as Exhibit G to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 25, and, on that basis, denies each and every such averment.

26. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 26 of the Complaint, and, on that basis, denies each and every such averment.

PLATEAU SYSTEMS, LTD.'S ANSWER TO  
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27. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 27 of the Complaint, and, on that basis, denies each and every such averment.

28. In response to Paragraph 28 of the Complaint, Plateau admits that on its face, United States Patent No. 6,688,888 ("the '888 patent") is entitled "Computer-Aided Learning System and Method," that the '888 patent on its face names Chi Fai Ho and Peter P. Tong as alleged inventors, and that a copy of the '888 patent is attached as Exhibit H to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 28, and, on that basis, denies each and every such averment.

29. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 29 of the Complaint, and, on that basis, denies each and every such averment.

30. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 30 of the Complaint, and, on that basis, denies each and every such averment.

31. In response to Paragraph 31 of the Complaint, Plateau admits that on its face, United States Patent No. RE38,432 ("the '432 patent") is entitled "Computer-Aided Group-Learning Methods and Systems," that the '432 patent on its face names Ho Chi Fai and Peter P. Tong as alleged inventors, and that a copy of the '432 patent is attached as Exhibit I to the Complaint. Plateau is without knowledge or information sufficient to form a belief as to the truth of the remaining averments contained in paragraph 31, and, on that basis, denies each and every such averment.

32. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 32 of the Complaint, and, on that basis, denies each and every such averment.

PLATEAU SYSTEMS, LTD.'S ANSWER TO  
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33. Plateau is without knowledge or information sufficient to form a belief as to the truth of the averments contained in paragraph 33 of the Complaint, and, on that basis, denies each and every such averment.

34. In response to Paragraph 34 of the Complaint, Plateau admits that it has a product called Plateau Learning Management System. Except as expressly admitted, Plateau denies the averments of Paragraph 34 of the Complaint.

35. Plateau denies each and every averment of Paragraph 35 of the Complaint.

36. Plateau denies each and every averment of Paragraph 36 of the Complaint.

37. Plateau denies each and every averment of Paragraph 37 of the Complaint.

38. Plateau denies each and every averment of Paragraph 38 of the Complaint.

#### **ANSWER TO FIRST PURPORTED CAUSE OF ACTION**

39. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-38 above.

40. Plateau denies each and every averment of Paragraph 40 of the Complaint.

41. Plateau denies each and every averment of Paragraph 41 of the Complaint.

42. Plateau denies each and every averment of Paragraph 42 of the Complaint.

43. Plateau denies each and every averment of Paragraph 43 of the Complaint.

44. Plateau denies each and every averment of Paragraph 44 of the Complaint.

#### **ANSWER TO SECOND PURPORTED CAUSE OF ACTION**

45. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-44 above.

46. Plateau denies each and every averment of Paragraph 46 of the Complaint.

47. Plateau denies each and every averment of Paragraph 47 of the Complaint.

48. Plateau denies each and every averment of Paragraph 48 of the Complaint.

49. Plateau denies each and every averment of Paragraph 49 of the Complaint.

50. Plateau denies each and every averment of Paragraph 50 of the Complaint.

PLATEAU SYSTEMS, LTD.'S ANSWER TO  
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**ANSWER TO THIRD PURPORTED CAUSE OF ACTION**

51. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-50 above.

52. Plateau denies each and every averment of Paragraph 52 of the Complaint.

53. Plateau denies each and every averment of Paragraph 53 of the Complaint.

54. Plateau denies each and every averment of Paragraph 54 of the Complaint.

55. Plateau denies each and every averment of Paragraph 55 of the Complaint.

56. Plateau denies each and every averment of Paragraph 56 of the Complaint.

**ANSWER TO FOURTH PURPORTED CAUSE OF ACTION**

57. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-56 above.

58. Plateau denies each and every averment of Paragraph 58 of the Complaint.

59. Plateau denies each and every averment of Paragraph 59 of the Complaint.

60. Plateau denies each and every averment of Paragraph 60 of the Complaint.

61. Plateau denies each and every averment of Paragraph 61 of the Complaint.

62. Plateau denies each and every averment of Paragraph 62 of the Complaint.

**ANSWER TO FIFTH PURPORTED CAUSE OF ACTION**

63. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-62 above.

64. Plateau denies each and every averment of Paragraph 64 of the Complaint.

65. Plateau denies each and every averment of Paragraph 65 of the Complaint.

66. Plateau denies each and every averment of Paragraph 66 of the Complaint.

67. Plateau denies each and every averment of Paragraph 67 of the Complaint.

68. Plateau denies each and every averment of Paragraph 68 of the Complaint.

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**ANSWER TO SIXTH PURPORTED CAUSE OF ACTION**

69. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-68 above.

70. Plateau denies each and every averment of Paragraph 70 of the Complaint.

71. Plateau denies each and every averment of Paragraph 71 of the Complaint.

72. Plateau denies each and every averment of Paragraph 72 of the Complaint.

73. Plateau denies each and every averment of Paragraph 73 of the Complaint.

74. Plateau denies each and every averment of Paragraph 74 of the Complaint.

**ANSWER TO SEVENTH PURPORTED CAUSE OF ACTION**

75. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-74 above.

76. Plateau denies each and every averment of Paragraph 76 of the Complaint.

77. Plateau denies each and every averment of Paragraph 77 of the Complaint.

78. Plateau denies each and every averment of Paragraph 78 of the Complaint.

79. Plateau denies each and every averment of Paragraph 79 of the Complaint.

80. Plateau denies each and every averment of Paragraph 80 of the Complaint.

**ANSWER TO EIGHTH PURPORTED CAUSE OF ACTION**

81. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-80 above.

82. Plateau denies each and every averment of Paragraph 82 of the Complaint.

83. Plateau denies each and every averment of Paragraph 83 of the Complaint.

84. Plateau denies each and every averment of Paragraph 84 of the Complaint.

85. Plateau denies each and every averment of Paragraph 85 of the Complaint.

86. Plateau denies each and every averment of Paragraph 86 of the Complaint.

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### **ANSWER TO NINTH PURPORTED CAUSE OF ACTION**

87. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-86 above.

88. Plateau denies each and every averment of Paragraph 88 of the Complaint.

89. Plateau denies each and every averment of Paragraph 89 of the Complaint.

90. Plateau denies each and every averment of Paragraph 90 of the Complaint.

91. Plateau denies each and every averment of Paragraph 91 of the Complaint.

92. Plateau denies each and every averment of Paragraph 92 of the Complaint.

### **AFFIRMATIVE DEFENSES**

93. For its further and separate affirmative defenses to the Complaint, Plateau avers as follows. In setting forth these affirmative defenses, Plateau does not intend to take on any burdens of proof that it would not otherwise have. Also, the '486 patent, the '909 patent, the '973 patent, the '448 patent, the '780 patent, the '556 patent, the '478 patent, the '888 patent, and the '432 patent are collectively referred to as "the Asserted Patents."

#### **First Affirmative Defense**

94. One or more of the Asserted Patents are invalid because they fail to satisfy the requirements of Part II of Title 35 of the United States Code, including, but not limited to, one or more of 35 U.S.C. §§ 101, 102, 103 and/or 112.

#### **Second Affirmative Defense**

95. Plateau does not infringe any valid, enforceable claim of any of the Asserted Patents. In addition, Plateau has not directly infringed, contributed to infringement or induced infringement of any valid, enforceable claim of the Asserted Patents, nor is Plateau directly infringing, contributing to infringement or inducing infringement of any valid, enforceable claim of the Asserted Patents.

PLATEAU SYSTEMS, LTD.'S ANSWER TO  
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**Third Affirmative Defense**

96. Plateau is informed and believes, and on that basis avers, that by reason of the proceedings in the United States Patent and Trademark Office during the prosecution of the applications which resulted in one or more of the Asserted Patents, and by reason of the admissions and representations therein made by or on behalf of the applicant for one or more of the Asserted Patents, IpLearn is estopped from construing the claims of one or more of the Asserted Patents, even if this were otherwise possible, to cover and include any acts of Plateau.

**Fourth Affirmative Defense**

97. Plateau's products are so far changed in principle from those disclosed in the Asserted Patents, and are so different in structure, function, operation, and result from those disclosed in the Asserted Patents, that Plateau's products function in a substantially different way from, and are substantially different than the Asserted Patents.

**Fifth Affirmative Defense**

98. IpLearn's claims are barred by the doctrine of laches.

**Sixth Affirmative Defense**

99. IpLearn's claims are barred in whole or in part by delay in prosecuting one or more of the applications resulting in the Asserted Patents.

**Seventh Affirmative Defense**

100. Some or all of IpLearn's claims based on the '432 patent are barred by the principles of intervening rights, as set forth in 35 U.S.C. Section 252, first and second paragraphs.

**Eighth Affirmative Defense**

101. The '478 patent, the '888 patent, and the '432 patent are unenforceable due to IpLearn's inequitable conduct, for the reasons set forth in paragraphs 1-19 of Plateau's counterclaim below, and incorporated herein by reference.

PLATEAU SYSTEMS, LTD.'S ANSWER TO  
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**Ninth Affirmative Defense**

102. IpLearn is barred by its unclean hands from seeking equitable relief from the Court.

**Tenth Affirmative Defense**

103. IpLearn is not entitled to injunctive relief because any injury to IpLearn is not immediate or irreparable and IpLearn has an adequate remedy at law.

**COUNTERCLAIM**

For its counterclaim against IpLearn, Plateau avers:

**The Parties**

1. Plateau is a corporation organized under the laws of the State of Delaware, with its principal place of business in Arlington, Virginia.

2. Plateau is informed and believes, and on that basis avers, that IpLearn is a limited liability company organized under the laws of California, having its principal place of business at 1807 Linnetree Lane, Mountain View, California.

**Jurisdiction and Venue**

3. This Court has subject matter jurisdiction over this counterclaim pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202 because the counterclaim arises under the patent statutes of the United States.

4. Venue is proper in this district pursuant to 28 U.S.C. § 1391(b).

**Facts**

5. As set forth below, IpLearn has engaged in a scheme of procuring and attempting to enforce patents obtained by inequitable conduct and/or fraud on the U.S. Patent and Trademark Office ("USPTO"), including one or more of the Asserted Patents which are the subject of this action; namely U.S. Patent Nos. 5,779,486 ("the '486 patent"), 5,934,909 ("the '909 patent"), 6,118,973 ("the '973 patent"), 6,126,448 ("the

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'448 patent"), 6,213,780 ("the '780 patent"), 6,398,556 ("the '556 patent"), 6,685,478 ("the '478 patent"), 6,688,888 ("the '888 patent"), and RE38,432 ("the '432 patent").

6. Each of the '486 patent, the '909 patent, the '973 patent, the '448 patent, the '780 patent, and the '556 patent issued before July, 2002.

7. In or about April, 2002, IpLearn started a series of lawsuits against a number of companies. These lawsuits included, among others:

a. A lawsuit against Smartforce.plc, Case No. 02-1977 in the U.S. District Court for the Northern District of California, filed on or about April 23, 2002 ("the Smartforce lawsuit");

b. A lawsuit against SkillSoft Corp., Case No. 02-2632 in the U.S. District Court for the Northern District of California, filed on or about May 31, 2002 ("the SkillSoft lawsuit");

c. A lawsuit against Saba Software, Inc., Case No. 02-2634 in the U.S. District Court for the Northern District of California, filed on or about May 31, 2002 ("the Saba lawsuit");

d. A lawsuit against Docent, Inc., Case No. 02-2636 in the U.S. District Court for the Northern District of California, filed on or about May 31, 2002 ("the Docent lawsuit"); and

e. A lawsuit against Digital Think, Inc. et al., Case No. 02-4114 in the U.S. District Court for the Northern District of California, filed on or about August 27, 2002 ("the Digital Think lawsuit").

The above lawsuits are collectively sometimes referred to as "the 2002 Lawsuits."

8. In the 2002 Lawsuits, IpLearn accused the respective defendants of infringing one or more of the '486 patent, the '909 patent, the '973 patent, the '448 patent, the '780 patent, and the '556 patent.

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9. By reason of the following facts, among other things, the applications for each of the '478 patent, the '888 patent, and the '432 patent were pending during the pendency of the 2002 Lawsuits:

a. The '478 patent is based on an application filed on or about March 30, 2002. Plateau is informed and believes, and on that basis avers, that IpLearn asserts that the '478 patent is a continuation of the '556 patent, and is entitled to the benefit of the April 13, 1999 filing date of the '556 patent. Plateau is also informed and believes, and on that basis avers, that IpLearn asserts that the '478 patent is entitled at least in part to the benefit of the July 6, 1998 filing date of the '448 patent.

b. The '888 patent is based on an application filed on or about September 6, 2000. Plateau is informed and believes, and on that basis avers, that IpLearn asserts that the '888 patent is entitled at least in part to the benefit of the March 19, 1996 filing date of the '486 patent.

c. The '432 patent is based on a reissue application filed on or about October 6, 2002.

d. Each of the '478 patent, the '888 patent, and the '432 patent issued during February, 2004. Specifically, the '478 patent issued on February 3, 2004; the '888 patent issued on February 10, 2004; and the '432 patent issued on February 24, 2004. This was well after the filing of the 2002 Lawsuits between April and August, 2002.

10. Each of the applications for the '478 patent, the '888 patent, and the '432 patent were prosecuted by the same attorney, Peter P. Tong. Dr. Tong is also one of the named inventors for each of the '478 patent, the '888 patent, and the '432 patent. Plateau is informed and believes, and on that basis avers, that in addition to a J.D. degree from Santa Clara University, Dr. Tong also has an MBA from Santa Clara University and a Ph.D. in electrical engineering from the California Institute of Technology, and that Dr. Tong is the managing partner of IpLearn.

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11. During the course of the 2002 Lawsuits, and before the '478 patent, the '888 patent, and the '432 patent issued during February 2004, there were a number of pleadings, discovery, and other evidence generated by the parties and/or the court. These included, among other things:

- a. Answers and counterclaims filed during one or more of the 2002 Lawsuits that raised invalidity as a defense;
- b. Preliminary invalidity contentions submitted during 2002 and 2003 in at least the Smartforce lawsuit, the SkillSoft lawsuit and the Saba lawsuit;
- c. Claim construction briefing and a March 21, 2003 Claims Construction Order in the Saba lawsuit, which construed claim terms from the '486 patent, the '909 patent, the '973 patent, the '448 patent, the '780 patent, and the '556 patent;
- d. Summary judgment briefing in the Saba lawsuit regarding the '486 patent, the '909 patent, the '973 patent, the '448 patent, the '780 patent, and the '556 patent, which resulted in a June 12, 2003 court order.

The above materials are collectively referred to as the "2002 Lawsuit Materials."

12. IpLearn and Dr. Tong became aware of the 2002 Lawsuit Materials during 2002 and 2003, while the applications for the '478 patent, the '888 patent, and the '432 patent were pending, and before those patents issued in February, 2004.

13. IpLearn and its attorneys had a duty to disclose both the existence of the 2002 Lawsuits, and material documents from the 2002 Lawsuits, to the USPTO during the prosecution of the applications that resulted in each of the '478 patent, the '888 patent, and the '432 patent. Among other things, pursuant to 37 C.F.R. Section 1.56, IpLearn and its attorneys had a duty to disclose information (a) that was not cumulative to information already of record or being made of record in the applications, and which establishes, by itself or in combination with other information, a *prima facie* case of

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unpatentability of a patent claim; and/or (b) if there was a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent. Also, the USPTO Manual of Patent Examining Procedure, Section 2001.06(c) provides in part as follows:

Where the subject matter for which a patent is being sought is or has been involved in litigation, the existence of such litigation and any other material information arising therefrom must be brought to the attention of the U.S. Patent and Trademark Office. Examples of such material information include evidence of possible prior public use or sales, questions of inventorship, prior art, allegations of 'fraud,' 'inequitable conduct,' and 'violation of duty of disclosure.' Another example of such material information is any assertion that is made during litigation which is contradictory to assertions made to the examiner. *Environ Prods., Inc. v. Total Containment, Inc.*, 43 USPQ2d 1288, 1291 (E.D. Pa. 1997). Such information might arise during litigation in, for example, pleadings, admissions, discovery including interrogatories, depositions, and other documents and testimony.

14. Plateau is informed and believes, and on that basis avers, that at least since 2002, IpLearn was represented by Dr. Tong as its patent counsel, who was aware of the principles of patent law in general, and specifically of the duty of disclosure pursuant to 37 C.F.R. Section 1.56 and the MPEP quoted above.

15. IpLearn thus had a duty to disclose the existence of the 2002 Lawsuits and the 2002 Lawsuit Materials to the USPTO in the applications for each of the '478 patent, the '888 patent, and the '432 patent.

16. IpLearn did not disclose any of the 2002 Lawsuit Materials to the USPTO in the applications for any of the '478 patent, the '888 patent, and the '432 patent. Indeed, IpLearn did not even inform the USPTO of the existence of the 2002 Lawsuits in the applications for any of the '478 patent, the '888 patent, and the '432 patent.

17. IpLearn did disclose a large quantity of prior art references to the USPTO in the applications for the '478 patent, the '888 patent, and the '432 patent from the 2002 Lawsuits, but without the accompanying disclosure of the 2002 Lawsuit Materials. IpLearn's disclosure of the bare references themselves served to "bury" the examiners

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with a large quantity of references without the explanation that the 2002 Lawsuit Materials would have provided. Thus, IpLearn's failure to disclose the 2002 Lawsuit Materials deprived the USPTO of highly material information.

18. Plateau is informed and believes, and on that basis avers, that IpLearn and Dr. Tong knew of the materiality of the 2002 Lawsuit Materials, but nevertheless intentionally withheld the 2002 Lawsuit Materials during the prosecution for the applications for the '478 patent, the '888 patent, and the '432 patent, with the intent to deceive the USPTO and in order improperly to obtain the allowance of the '478 patent, the '888 patent, and the '432 patent.

19. Therefore, each of the '478 patent, the '888 patent, and the '432 patent are unenforceable.

**Counterclaim for Declaratory Relief**

20. Plateau realleges its admissions, denials, and averments as set forth in Paragraphs 1-19 above.

21. Plateau is informed and believes, and on that basis avers, that IpLearn contends that the Asserted Patents are valid and enforceable, and that Plateau has infringed said patents.

22. Plateau contends that the Asserted Patents are not valid, not enforceable, and/or are not infringed, for the reasons set forth above. Accordingly, a valid and justiciable controversy has arisen and exists between Plateau and IpLearn. Plateau desires a judicial determination and declaration of the respective rights and duties of the parties herein in accordance with Plateau's foregoing contentions. Such a determination and declaration is necessary and appropriate at this time in order that the parties may ascertain their respective rights and duties.

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**DEMAND FOR JURY TRIAL**

23. Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plateau demands a trial by jury of this action.

**PRAYER FOR RELIEF**

WHEREFORE, Plateau prays for judgment as follows:

- A. That IpLearn take nothing by its Complaint, and that the same be dismissed with prejudice;
- B. For a declaration that U.S. Patent Nos. 5,779,486, 5,934,909, 6,118,973, 6,126,448, 6,213,780, 6,398,556, 6,685,478, 6,688,888, and RE38,432 are invalid, are not enforceable, and are not infringed by Plateau;
- C. For Plateau's reasonable attorneys' fees and costs of suit incurred herein;
- and

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D. For such other and further relief as the Court may deem just and proper.

Dated: January 25, 2007

WILSON SONSINI GOODRICH & ROSATI  
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PLATEAU SYSTEMS, LTD.

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**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who are deemed to have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by certified mail, return receipt requested, on this the 25th day of January, 2007.

/s Michael Barclay

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